

REMARKS

Status of Application

Claims 29-31 are all the claims pending in the Application. Claims 29-31 are amended.

Claim Rejections Under 35 U.S.C. § 112

Claims 29-31 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant traverses this rejection for at least the following reasons.

The Examiner contends that “the originally filed specification of 12/18/2001 does not disclose tracking the number of times a song is played.” (Office Action at 2.) The Examiner asserts that the “taste” referred to in the specification is “based on how long ago (frequently) a user played music, not how many times the user has played the music.” Applicant respectfully disagrees with the Examiner’s understanding of the disclosure.

Regarding the “taste” referred to by the Examiner, the specification states that “taste information 24 indicat[es] the taste for the piece of music (namely, the taste indicating how much frequently the user has listened to the piece of music).” (Specification at ¶ [0107].) The specification further states the following with respect to “taste information”:

[W]henver one listening is complete, the last listening date information 26, [and] the taste information 24, . . . are updated in accordance with a mode of listening. More specifically, when the user listened to the same piece of music M again and again on the same day, the last listening date information 26 of the piece of music M is not updated; on the other hand, the taste information 24 is updated each time the user listens to the piece of music M.

(Specification at ¶ [0143].)

Although the Examiner argues that the “taste” referred to in the specification is “based on how long ago” a piece of music was played, it is clear from the above-quoted portion of the

specification that this purpose is already served by the “last listening date information 26” in the described embodiment. This is even further clarified by the fact that, as stated in the above quotation regarding this exemplary embodiment, the last listening date information is not always updated each time the user listens to the piece of music, while the taste information must be updated every time the music is listened to. Thus, one of ordinary skill in the art would necessarily understand that in the described embodiment, the “taste information” does not refer to “how long ago” a piece of music was played, but rather, to how many times it was played.

Furthermore, the Examiner’s interpretation of the “taste information” is clearly not possible once the following portions of the disclosure are considered:

[W]hen the user listens to the piece of music M in the server 1, the CPU 4 . . . increments the taste information of the piece of music M contained in the correspondence information T.

...
[T]he CPU 14 reads the correspondence information T corresponding to the piece of music M for the user to listen to . . . and increments the taste information of the piece of music M contained in the correspondence information T.

(Specification at ¶¶ [0118], [0133].)

Thus, it is clear that in the described exemplary embodiments that the “taste information” for a piece of music is incremented each time the piece of music is listened to. As such, the only way that one of ordinary skill in the art could reasonably interpret the described “taste information” is as the number of times a piece of music is played.

The described “taste information,” therefore, clearly supports the recitation of “number of plays of each of said pieces of music” in claims 29-31. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 29-31.

Claim Rejections Under 35 U.S.C. § 102

Claims 29-31 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,572,381 to Tsai ("Tsai"). Applicant traverses this rejection for at least the following reasons.

Claim 29 is amended to require "a reproducing section which reproduces said data of pieces of music," and to require that "the portable terminal" is "capable of being carried for reproducing said data of pieces of music by a user." Claims 30 and 31 recite features similar to these features of claim 29.

The Examiner contends that the elements of claims 29-31 are taught by Tsai, citing col. 8, lines 46-61, and col. 22, lines 45-67 of that reference.

It should first be emphasized that the system disclosed in Tsai is completely different from the claimed invention. Whereas the claimed invention is directed to a portable terminal for listening to pieces of music which may be carried by a user for reproducing pieces of music, Tsai is directed to a karaoke system, the terminals of which are not portable, and do not allow a user to carry them to reproduce music in a portable manner.

None of the cited portions of Tsai appear to disclose that the described karaoke terminals are portable or are capable of being carried for reproducing music by a user. For example, col. 8, lines 46-61 of Tsai merely appear to describe various types of data, including MIDI data, which is transferred to the karaoke terminal from the host computer 1. Furthermore, col. 22, lines 45-67 of Tsai appear to describe logging which menus or information surfaces have been executed, and transferring this information to the host computer 1 from the karaoke terminal. Neither the cited portions of Tsai, nor the remainder of that reference, appear to contain any teaching that the karaoke terminals may be portable, as required by claims 29-31.

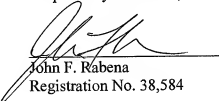
Thus, Tsai fails to identically disclose each and every required element of claims 29-31. Tsai, therefore, fails to anticipate these claims. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Application is being filed via the USPTO Electronic Filing System (EFS). Applicants herewith petition the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


John F. Rabena
Registration No. 38,584

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: May 6, 2008